

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Philip L. Camillocci et al.	§	Group Art Unit: 3739
	§	
Serial No.: 10/706,197	§	Examiner: Kasztejna, M.
	§	
Filed: November 12, 2003	§	Confirmation No.: 5978
	§	
For: ENDOSCOPE COVER	§	Atty. Docket: 132387-1 IT/YOD/GIL
	§	GEMS:0230
	§	

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION OR MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. § 1.6(d), or is being transmitted via the Office electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), or is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

October 16, 2007

Date

/Patrick S. Yoder/

Patrick S. Yoder

REPLY BRIEF PURSUANT TO 37 C.F.R. §§41.41

Appellants submit this Reply Brief pursuant to 37 C.F.R. §§41.41, and in response to the Examiner's Answer mailed on August 17, 2007. Appellants, however, respectfully request that the Board consider Appellants' complete arguments set forth in the previously filed Appeal Brief, in addition to the following remarks.

Appellants have carefully reviewed the Examiner's arguments and the response to the arguments advanced in the Examiner's Answer. Appellants maintain that the combination of Kieffer and Yabe 074 and/or Yabe 133 does not render the claims obvious. Appellants respectfully submit that the Examiner's position, effectively equating Appellants' endoscope and endoscope cover to Kieffer's otoscope and speculum, respectively, is flawed. As Appellants have stressed in previously filed Responses and in the previously filed Appeal Brief, such equivalence can not be

maintained because Kieffer does not disclose or suggest an endoscope cover, much less a cover suitable for being disposed on an endoscope *while the endoscope is not in use*. Moreover, Kieffer is clearly non-analogous art, as demonstrated in the previously filed Appeal Brief.

More particularly, in the Examiner's answer, the Examiner stated that "if the prior art structure is capable of performing the intended use, then it meets the claim." *See*, Examiner's Answer, page 8. This contention clearly amplifies the deficiency of the 103 rejection advanced by the Examiner. Appellants stress that the structure of the otoscope and the speculum are clearly distinct from the structure of the claimed endoscope and endoscope cover, respectively. In other words, stark structural distinctions existing between the endoscope and the otoscope, necessitate clear structural distinctions, as well, between the claimed endoscope cover and the speculum taught by Kieffer. The speculum taught by Kieffer can not be securely fitted to an endoscope and, therefore, the speculum is incapable of performing as does the claimed endoscope cover. Therefore, the same reasoning used by the Examiner, *a contrario*, would lead to the conclusion that because the structure disclosed by the prior art is incapable of performing the intended use, then the prior art does not teach the structure recited in the claim. At the very least, the Examiner has provided no basis for asserting that the Kieffer speculum, even modified, would have any reasonable likelihood of success as an endoscope cover. The Examiner has failed to establish *prima facie* obviousness for this reason alone.

In addition, Kieffer discloses a device specifically designed to be used on an otoscope *when in use*. Specifically, Kieffer teaches a removable speculum which contains a "rubber-like tip bounded upon the distal end thereof for protecting the ear canal and forming a seal therewith." *See*, Kieffer, Abstract and Fig. 1. Thus, the otoscope cover taught by Kieffer would *only* be used during examinations, as it is intended to facilitate use of the otoscope *and* to promote patient comfort. The Examiner, however, alleges that the "speculum offers protection to the distal end of the endoscope, both during use and when not in use (i.e., transporting the instrument)." *See*, Examiner's

Answer, p. 8. Appellants submit to the Board that the aforementioned contention set forth by the Examiner is supported neither by Kieffer nor by any teachings or showings of individuals having ordinary skill in this art. Again, the otoscope cover taught by Kieffer would only be used during patient examination.

Appellants further wish to reiterate, as stated in previous Responses, that the subject matter disclosed by Kieffer is non-analogous art. Accordingly, Appellants submit that the prior art used in this case is not within the field of the inventors' endeavor. Specifically, Kieffer teaches a device apparently meant to aid clinicians specializing in medicine related to the ear, nose and/or throat. In contrast, the Appellants' endeavor is in the field of internal medicine. This is the clear field of use of an endoscope. While the Examiner maintains that "an endoscope is, by definition an endoscope," Appellants submit that the mere fact that the device claimed in the present patent application and the one disclosed in Kieffer are both used in the general field of medicine is insufficient to regard them as in the same field, much less as identical devices. *See*, Examiner's Answer, page 9.

Further, Appellants submit that Kieffer is not reasonably pertinent to the particular problem with which the inventors are involved. The speculum taught by the cited reference is meant to protect the ear canal as it is probed. The endoscope cover presently claimed is meant to protect *an endoscope while it is not in use* and, in so doing, it properly maintains the sterile condition of the endoscope when it is not in use. Indeed, the claimed endoscope cover would never be used while the endoscope is in use. These are two very distinct problems. As one having ordinary skill in the art would appreciate, a design of a cover for an apparatus used in a medical procedure, where the cover may contact delicate organs of a human body during a procedure (as in Kieffer), is clearly distinct from a design of a cover configured to protect an apparatus, such as an endoscope, while not in use. Accordingly, Kieffer is not reasonably pertinent to the particular problem with which the inventors were involved. Accordingly, Appellants submit, here again, that subject matter taught by the Kieffer reference is non-analogous.

With respect to the claim rejections in view of Yabe '074, Appellants contend that Yabe '074 teaches an endoscope cover disposed on a probe end of an endoscope *while the endoscope is in use*. That is, the reference teaches a cover disposed on an instrument insertable into a body of a patient. Accordingly, Yabe '074 does not teach or suggest a cover configured to be disposed on the tip of a probe end of an endoscope only when the endoscope is not in use, as recited by the claims. Moreover, the Examiner did not argue, nor does Yabe '074 support the contention that the Yabe cover could or should be modified to perform as does the claimed invention. Again, Appellants reiterate that the Examiner has failed to show any predictability of success of combining Kiefer with any of the above aforementioned references.

Consequently, the combination of Kieffer and Yabe '074 and/or Yabe '0133 clearly does not and cannot establish a *prima facie* case of obviousness of independent claim 1, 8, 15, 22, 27, 31 and 36 or any claims depending therefrom.

Respectfully submitted,

Date: October 16, 2007

/Patrick S. Yoder/

Patrick S. Yoder

Reg. No. 37,479

FLETCHER YODER

P.O. Box 692289

Houston, TX 77269-2289

(281) 970-4545